

REMARKS

In an Office Action mailed December 4, 2003, the Examiner rejects all pending claims under Section 112, first paragraph, for failing to comply with both the written description requirement and the enablement requirement, and rejects all pending claims under Section 112, second paragraph, on the grounds that the claims are unclear. In all cases, the Examiner objects to applicants' use of the term "steady state" in the claims.

A. Response to Written Description Refusal

The Examiner asserts that the specification, as filed, failed to describe the invention, as currently claimed, in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of an inventive method that measured thermal conductivity before the system reached steady state. Applicants respectfully disagree, as described below and in the enclosed Declaration of one of the inventors.

As indicated in the enclosed Declaration, it would be clear to one of ordinary skill in the art that the present invention operates before the system reaches steady state. In particular, the Declaration establishes that insulating material can take about an hour to reach steady state. Thus, the invention, which is described as taking "a short period of time," "such as 120 seconds," clearly operates before the system reaches steady state.

Accordingly, applicants certainly had possession of the claimed invention when the application was filed, and the specification, as filed, contained sufficient detail to describe the invention to one of ordinary skill in the art. Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

B. Response to Enablement Refusal

The Examiner asserts that the description in the specification is insufficient to enable one of ordinary skill in the art to make and/or use the invention. Again, applicants respectfully disagree.

The specification describes exactly how to perform the inventive method, and even gives one example of an amount of time it may take to perform the inventive method.

Skilled engineers in the field of heat transfer know what steady state means, and engineers in the field of insulating materials generally know—and can find out with precision—how long it takes a particular material to reach steady state under certain heating conditions. Accordingly, knowing that a particular material may take about an hour to reach steady state, and provided with an invention that measures thermal conductivity in as little as two minutes or less, the engineer knows that the inventive method operates before the system has reached steady state.

Accordingly, applicants assert that the original description was of sufficient detail to enable one of ordinary skill in the art to use the inventive method. Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

C. Response to Section 112, Second Paragraph Rejection

The Examiner asserts that the term “steady state” is not defined in the specification and, as a result, is not clear when used in the claims. Applicants assert that the term “steady state” is commonly known and understood, and as such, need not be separately defined in the specification.

According to the inventor, as indicated in the Declaration, the term “steady state” is a universally understood term of art to those of ordinary skill in the art. In addition, the term “steady state” is defined in dictionaries and in standards published by the American National Standards Institute and the American Society for Testing and Materials. It has not been asserted by the Examiner that the term “steady state” has more than one possible meaning, only that the term is not described in the specification. However, as a universally known term of art having an undisputed meaning, it cannot be supported that the term is unclear. Thus, when used in a claim, it is clear what the inventors are claiming.

Applicants assert that the terms presently pending are clear, and respectfully request that the Examiner reconsider and withdraw the rejection under Section 112, second paragraph.

D. Conclusion

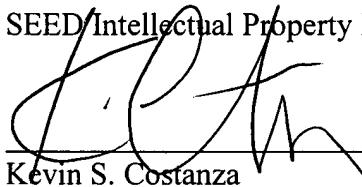
Applicants assert that the above comments and the enclosed Declaration resolve each of the rejections in the December 4, 2003 Office Action, and respectfully request that the application be allowed. The Examiner is invited to contact the undersigned to discuss any remaining issues.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



Kevin S. Costanza
Registration No. 37,801

KSC:ljs

Enclosures:

Postcard

Declaration of Masato Hayashi

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

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